



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,847	07/28/2003	James Jannard	NOCODE2.005C3	6079
29995 7590 03/18/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER DANG, HUNG XUAN				
ART UNIT 2873		PAPER NUMBER		
NOTIFICATION DATE 03/18/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/628,847

Applicant(s)

JANNARD ET AL.

Examiner

Hung X. Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-549)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The amendment filed on 11/26/07 has been entered.

Claims Rejection Under 35 USC - 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Bylander** (5,654,786).

Swab et al discloses eyewear with exchangeable temples housing a transceiver forming AD HOC networks with other device comprises eyeglass frame having an interactive device electronic device support by the frame (see figure 1 and the related disclosure).

Swab et al does not disclose the lens configured to have variable light attenuation.

Bylander, however, discloses the lens 50 configured to have variable light attenuation.

Because Swab et al and Bylander are both from the same field of endeavor, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Bylander would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Swab et al, with the lens configured to have variable light attenuation, such as disclosed by Bylander for the purpose of controlling the amount of light that is transmitted through the lens.

Claims Rejection Under 35 USC – 103

3. Claims 22-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Swab et al** (6,769,767) in view of **Young** (4,149,780) further in view of **Vogt et al** (5,606,743 in IDS filed 7/28/03).

Swab et al discloses eyewear with exchangeable temples housing a transceiver forming AD HOC networks with other device comprises eyeglass frame having an interactive device electronic device support by the frame (see figure 1 and the related disclosure).

Swab et al does not disclose the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position.

Young, however, discloses the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position (see figure 1 and the related disclosure.)

Because Swab et al and Young are both from the same field of endeavor, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Young would have been recognized as an art pertinent art of Swab et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Swab et al, with the first lens to pivot relative to the frame between at least first and second positions, wherein the lens provides a first magnitude of light attenuation when the first lens is in a first position and less light attenuation when the first lens is pivoted to the second position, such as disclosed by Young for the purpose of controlling the amount of light that is transmitted through the lens.

Swab et al does not disclose the speaker to be pivoted with respect to the frame to rigidly position.

Vogt et al disclose the speaker 76 to be pivoted with respect the frame to rigidly position (see at least figure 6 and the related disclosure.)

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Swab et al, with the speaker to be pivoted with respect to the frame rigidly position, such as disclosed by Vogt et al for the purpose of easy to adjust the earphone.

Response To Applicant's Argument

4. Applicant's arguments filed 11/26/07 have been fully considered but they are not persuasive.

Applicant argued that nothing in Swab teaches or suggests any devices related to light attenuation and nothing in Bylander teaches or suggests that such a system should or could be combined with eyewear that has other electronic system.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the purpose of controlling the amount of light that is transmitted through the lens as disclosed by Bylander would have been recognized as an art pertinent art of Swab et al.

Applicant's arguments with respect to claims 14-54 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2873

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

2/08

/HUNG DANG/

PRIMARY EXAMINER

TC 2800